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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,445	06/29/2001	Yoshifusa Togawa	122.1222RE	6318

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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10/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/893,445	Applicant(s) TOGAWA ET AL.	
	Examiner Pierre E. Elisca	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67,75,79,84,94,109 and 145-153 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67,75,79,84,94,109 and 145-153 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on 08/27/2009.
 2. Claims 67, 75, 79, 84, 94, 109 and 145-153 remain pending and have been examined.
 3. Claims 67, 75, 79, 84, 94, 109 and 145-153 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments* 258 F. 3d 1399, 59 USPQ2d 1597 (Fed. Cir 2001); *Hester Industries, Inc v. Stein, Inc*, 142 F. 3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F. 3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F. 2d 1429, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application shows that the broadening aspect (in the reissue) relates to subject matter that the applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims was not an error within the meaning of 35 USC 251 and the broader scope surrendered in the application cannot be recaptured by the filing of the present reissue application. See MPEP 1412.02
- Applicant employed judging if a file is infected and prohibiting use of the externally requested file. In the reissue application, applicant is deleting that language. A deliberate decision to alter claims in order to secure issuance of a patent is not error within the meaning of Section 251. Thus, the reissue statute cannot be construed in such a way that competitors, properly relying on

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prosecution history, become patent infringers when they do so. The applicants have argued the distinctions from the prior art they are now attempting to remove.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 67, 75, 79, 84, 94, 109 and 145-153 are rejected under 35 U.S.C. 102 (e) as being anticipated by Cozza (U.S. Pat. No. 5,502,815).

As per claims 67, 75, 79, 84, 94, 109 and 145-153 Arnold discloses a method/apparatus for increasing the speed at which computer viruses are detected stores initial state information concerning the file or volume which is being examined for a virus. This information is stored in a cache in a non-volatile storage medium and when files are subsequently scanned for viruses, the current state information is compared to the initial state information stored in the cache. Please note that the file can be infected with virus or without virus, the system comprising:

A virus scanner scanning a file stored in a storage device for infection with a virus, a quarantining device quarantining the file from non-infected file on the storage device, when the

file is infected (see., abstract, col 1-col 5. Please note that the limitation of quarantining the file is readable as isolating the infected virus see., Arnold in col 7, lines 3-8, specifically wherein said if one or more decoy programs is subsequently found to have changed from the original, protected version, it can be assumed that the changes are due to a virus. A comparison of each modified decoy program with its corresponding uninfected version enables a copy of the virus to be isolated from each decoy).

Applicant's newly added limitation of converting device converting the quarantined file into encoded data is also disclosed by Arnold in col 1, lines 45-63, specifically wherein said converting the binary machine code of the virus (or infected viruses) to an assembler version, analyzing the assembler code, selecting sections of code that appear to be unusual or virus like..).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 67, 75, 79, 84, 94, 109 and 145-153 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Arnold et al. (U.S. Pat. No. 5,440,723) in view of Cozza (U.S. Pat. No. 5,502,815).

As per claims 67, 75, 79, 84, 94, 109 and 145-153 Arnold discloses a periodic monitoring of a data processing system for anomalous behavior that may indicate the presence of an undesirable software entity such as a computer virus (which is readable as Applicant's claimed

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invention wherein said a data processing system which has the ability to deal with infection of a file with a virus), the system comprising:

A storage device storing files (see., abstract, fig 1A, items 24 and 26, col 3, lines 49-68);

A virus scanner detecting if a file stored in said storage device is infected with a virus (see., col 1, lines 45-68, col 2, lines 1-11, col 5, lines 29-45); and the limitation of converting device converting the quarantined file into encoded data when the infected file is detected is also disclosed by Arnold in col 1, lines 45-63, specifically wherein said converting the binary machine code of the virus (or infected viruses) to an assembler version, analyzing the assembler code, selecting sections of code that appear to be unusual or virus like..).

Arnold fails to explicitly disclose the limitation wherein said saving or storing a detected virus-infected file into a specific area within said storage device. However **Cozza** a method/apparatus for increasing the speed at which computer viruses are detected stores initial state information concerning the file or volume which is being examined for a virus. This information is stored in a cache in a non-volatile storage medium and when files are subsequently scanned for viruses, the current state information is compared to the initial state information stored in the cache (see., abstract, col 1-col 5. Please note that the file can be infected with virus or without virus).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the computer virus of Arnold by including the limitation detailed above as taught by Cozza because this would increase the speed at which a computer can scan for the presence of a computer virus.

RESPONSE TO ARGUMENTS

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8. Applicant's arguments with respect to claims 67, 75, 79, 84, 94, 109 and 145-153 have been fully considered but they are not persuasive.

REMARKS

9. In response to Applicant's arguments filed on 08/27/2009, Applicant continues to argue that:

a. Arnold discusses converting a part of the virus code to a human recognizable assembler for producing a signature. Whereas claims 67, 75, 79, 84, 94 and 109 call for converting "an infected file" into another encoded data. However, the Examiner respectfully disagrees with this assertion since Arnold in col 1, lines 45-63, **specifically wherein said converting the binary machine code of the virus (or infected viruses) to an assembler version, analyzing the assembler code, selecting sections of code that appear to be unusual or virus like..).**

b. Applicant further argues that the prior art of record (Arnold and Cozza) fail to disclose the limitation of saving a detected virus. As indicated above, Cozza discloses this limitation in col 4, lines 59-67, fig 4, step 60, the detected virus is stored **or saved** in a cache in a non-volatile storage medium. Also, Arnold discloses an automatic scanning for occurrences of known types of undesirable software entities and taking remedial action if they are discovered. Therefore, the detected virus is stored in a signature database, see., Arnold, abstract.

NOTE

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10. Applicant is advised to incorporate the security concept of his invention into the claims in order to expedite prosecution.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00. Hotelier.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pierre E. Elisca/
Primary Examiner, Art Unit 3621